

REMARKS

Claims 1 – 3, 5 – 80 and 83 – 89 were previously pending in this application. By this amendment, claim 32 is canceled without prejudice or disclaimer. No claims have been amended, and no new claims have been added. As a result claims 1 – 3, 5 – 31, 33 – 80 and 83 – 89 are pending for examination with claims 1, 9, 70, 79, 86, 88, and 89 being independent claims. No new matter has been added.

Rejection under 35 U.S.C. §112

The Office Action rejected claim 32 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Without acceding to the appropriateness of this rejection, claim 32 has been canceled, thus mooted this rejection. Accordingly, withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. §103

Claims 1 – 3, 4 – 58, 66 – 75, 77 – 80, 83 – 89 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,398,645 (“Yoseloff”) and further in view of U.S. Patent No. 5,727,786 (“Weingardt”). Applicant notes that claims 4 and 32 have been canceled and the rejection is therefore moot as applied to these claims. In response, Applicant respectfully traverses this rejection and submits the following with respect to Yoseloff and Weingardt.

Yoseloff relates to “[t]he standard game of Bingo” with bingo cards provided to participants. (Column 5, lines 53 – 54.) The bingo cards have individual squares, and prior to playing the game every square on the bingo card is occupied by either a number or a “Free Space.” (Column 5, lines 62 – 67.) The numbers in the game of Yoseloff comply with the numerical limits of each column of the bingo cards. (Column 5, line 53 to column 6, line 8.)

In the game of Yoseloff, every square in every column and in every row of a bingo card contains either a number or a Free Space indicator in order to play a game. (Column 5, line 53 to column 6, line 8.) As Yoseloff states: “The standard game of Bingo provides each player with at least one bingo card with an odd-by-odd number of squares on the card. The most traditional game has 5x5 columns and rows with from 10 to 20 numbers available in each column (e.g., column B may have numbers 1 – 15 available, column I may have numbers 15 – 30 available...)”

Each card will have five different numbers listed in each column. It is also very common to have the center square (the third square down on the N column) denoted as a ‘Free Space.’ That is, the space is treated as if that particularly numbered space has already been called and filled... the first player to have numbers called that form a completely filled column, row, or diagonal (or in some cases a complete card or multiple lines or rows) wins the game.” (Column 5, line 53 to column 6, line 8.) Therefore, Yoseloff discloses a game where every square in every column and every square in every row of a bingo card must be occupied by either a number or by a Free Space indicator in order to win the game. None of the squares of the bingo cards of Yoseloff contain a blank spot. Indeed, as acknowledged on page 4 of the Office Action, “Yoseloff fails to teaches (sic) of a blank spot, as part of the said row or column.” (Office Action, page 4.)

Yoseloff further discloses a five step method “[i]n the play of the present game” in which the game is won. (Column 6, line 18 to column 7, line 2.) In this method, the player can “construct cards with player selected numbers in each square (although without the same number being repeated within a single bingo card).” (Column 6, lines 37 – 40.) To win the game of Yoseloff, “[t]he apparatus (e.g., software or hardware) compares the second set of numbers to the numbers on each of the... bingo cards. The matching numbers (between the randomly selected second set of numbers and the numbers on the bingo cards) on at least the selected bingo cards are identified and recognized... The apparatus then awards credits or money to the player for achieving any payout lines...” (Column 6, line 59 to column 7, line 2.) Thus, to win the game of Yoseloff, a player must match numbers printed on the bingo card with randomly selected numbers to achieve a completely filled payout line.

Weingardt relates to “English Bingo.” In English Bingo, “[e]ach player has a bingo card with multiple horizontal rows, each row having five numbers therein with the rest of the row comprising one or more blank (free) spaces.” (Column 2, lines 7 – 13.) Please also see Figures 5A and 5B of Weingardt, which “each shows a representative bingo card used in English Bingo. Each player has a bingo card with one or more horizontal rows, each row having only five numbers therein and one or more blank (free spaces).” (Column 8, lines 25 – 29; Figures 5A and 5B.)

Weingardt thus teaches a game of English Bingo where rows of a bingo card each have only five numbers, regardless of the length of the rows, and where each row has one or more blank spaces. (Figures 5A and 5B.)

On page 4 of the Office Action, the Examiner states that “[i]t would have been obvious... to have modified Yoseloff to includes (sic) one or more blank spots as well as free spot as taught by Weingardt, to allow players to easily achieve winning pattern, thus keeping player interested and consequently playing longer.” Applicant respectfully disagrees with this assertion and submits that Yoseloff and Weingardt can not be combined for purposes of asserting a rejection under 35 U.S.C. §103.

The Basic Requirements of a Prima Facie Case of Obviousness Have Not Been Met:

First, Yoseloff cannot be combined with Weingardt because such a combination would render Yoseloff unsatisfactory for its intended purpose. MPEP 2143.01V states “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

The intended purpose of Yoseloff is to play a wagering game that can be won. As Yoseloff states, “In the play of the present game, a method of playing a video-bingo type game on a video gaming apparatus having a video screen is taught in which game wagers are placed on the outcome of a bingo-type game.” (Column 6, lines 18 – 21.) Yoseloff also states that “the first player to have numbers called that form a completely filled column, row, or diagonal (or in some cases a complete card or multiple lines or rows) wins the game.” (Column 6, lines 2 – 4.)

As discussed above, the bingo card of Yoseloff must include a number in each space, and the game is won when there are matches completely filled column, row, diagonal, or other pattern between the numbered spaces and the selected numbers. The “Free Space” in Yoseloff is not blank, and is “treated as if that particularly numbered space has already been called and filled.” (Column 5, lines 65 – 67.) The squares that form the bingo card of Yoseloff cannot have any squares with blank spaces if they are to form part of the winning payout line. (Column 6, line 59 to column 7, line 2.) In direct contradiction, the bingo card of Weingardt must include one or more squares with blank spaces that are neither numbered spaces nor wild card spaces, and that are not matched to any selected numbers in order to win. (Weingardt, at column 2, lines 13 – 16 and Figures 5A-B.) Modifying the bingo card squares of Yoseloff to include the blank spaces of Weingardt makes it impossible to achieve the completely filled payout line required to win the game that is the invention of Yoseloff. This renders the invention of Yoseloff unsatisfactory for its intended purpose, which is to play a game that can be won. In the game

that is the invention of Yoseloff, it is clear that a completely filled payout line is how the game is won, and that the payout line is filled by matching numbers in the squares with selected numbers, in conjunction with the Free Space, which is treated as a matching number pair and filled in. As Yoseloff states, “[t]he method may be played wherein any numbers on selected bingo cards matching the second set of numbers are illuminated...” (Column 7, lines 3 – 5.) This is necessary in Yoseloff, because “the first player to have numbers called that form a completely filled column, row, or diagonal... wins the game.” (Column 6, lines 2 – 5.)

In Yoseloff, no row, column, or diagonal that includes a cell with a blank space can form the winning payout lines, as Yoseloff makes it clear that matches only occur when a called number matches the numbered spaces and the Free Space. Modifying the game that is the invention of Yoseloff so that it cannot be won renders the invention of Yoseloff unsatisfactory for its intended purpose. In particular, any blank spaces introduced into Yoseloff could not form part of a winning payout line of the game that is disclosed as the invention in Yoseloff, rendering Yoseloff unsatisfactory for its intended purpose. (Column 6, lines 62 to column 7, line 14.) Accordingly, and as per MPEP 2143.01V, withdrawal of this rejection of claims 1 – 3, 5 – 58, 66 – 75, 77 – 80, and 83 – 89 is respectfully requested.

Second, Yoseloff cannot be combined with Weingardt because such a combination would change the principle of operation of the invention as disclosed in Yoseloff. MPEP 2143.01VI states “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.”

In the game of Yoseloff, as discussed above, every square of the bingo card must be filled with a number or a “Free Space” indicator that is filled in as a matching square. (See column 5, line 62 to column 6, line 4, which states that for a 5 column by 5 row game card, “Each card will have five different numbers listed in each column.” It is also very common to have the center square (the third square down on the N column) denoted as a ‘Free Space.’ That is, the space is treated as if that particularly numbered space has already been called and filled... the first player to have numbers called that form a completely filled column, row, or diagonal (or in some cases a complete card or multiple lines or rows) wins the game. ” (Column 5, line 53 to column 6, line 8.) To win the game of Yoseloff, “[t]he apparatus (e.g., software or hardware) compares the second set of numbers to the numbers on each of the... bingo cards. The matching numbers

(between the randomly selected second set of numbers and the numbers on the bingo cards) on at least the selected bingo cards are identified and recognized... The apparatus then awards credits or money to the player for achieving any payout lines...” (Column 6, line 59 to column 7, line 2.)

In the game that is the invention as disclosed in Yoseloff, every square on the bingo card is occupied by a number or a Free Space. When numbers are called that match the numbers in the squares of the bingo card, these numbered squares are filled in by illumination. (Column 7, lines 3 – 14.) The game is won when the bingo card of a player has a completely filled in a column, row, or diagonal across the bingo card. (See column 6, lines 2 – 5, which states “[t]he first player to have numbers called that form a completely filled column, row, or diagonal (or in some cases a complete card or multiple lines or rows) wins the game.”)

The game of Yoseloff operates on the principle that there is a winner when selected numbers match numbers in the squares for every space in the payout line (e.g., row, column, or diagonal). Changing the game of Yoseloff to include blank spaces of Weingardt in any row, diagonal, or column of Yoseloff would change Yoseloff’s principle of operation. Any row, column, or diagonal of Yoseloff that is modified to include a blank space violates the requirement of Yoseloff that “[t]he first player to have numbers called that form a completely filled column, row, or diagonal (or in some cases a complete card or multiple lines or rows) wins the game.” (Column 6, lines 2 – 5.) Any such modification to Yoseloff modifies the principle of operation of Yoseloff, as it would be impossible to completely fill any row, column, or diagonal that contains a blank space, as required in Yoseloff, and changes the way that the game of Yoseloff is won, as a game with blank spots would have to be won in some undisclosed fashion different from the disclosed way to win in Yoseloff when a row, column, or diagonal across the bingo card is completely filled by matching the number in each square of that row, column, or diagonal with a selected number.

Modifying the game that is the invention of Yoseloff would vitiate the requirements of Yoseloff that “[e]ach [5x5] card will have five different numbers listed in each column” (that is, a number occupies every square of the column) and that “[t]he first player to have numbers called that form a completely filled column, row, or diagonal (or in some cases a complete card or multiple lines or rows) wins the game.”) (Column 5, line 62 – 63 and column 6, lines 2 – 5.) Any such modification to Yoseloff would create a new and different game than the game that is

the invention of Yoseloff. The basic rules by which Yoseloff operates would have to be changed to new and different rules regarding both: 1) how a player plays the game (i.e., something different than matching numbers for all squares of every payout line, save one Free Spot that is treated as if it has already been matched and filled); and 2) how a winner is determined (i.e., something different than winning when a payout line (e.g., row, column, or diagonal) is completely filled). This substantial reconstruction and redesign of the game that is the invention of Yoseloff changes its basic primary principle of operation. (Please see *In re Ratti*, 270 F.2d 810, 813.) A proposed modification that would change the principle of operation of the game that is the invention of Yoseloff is not sufficient to render the claims *prima facie* obvious as per MPEP 2143.01VI. Accordingly, withdrawal of this rejection of claims 1 – 3, 4 – 58, 66 – 75, 77 – 80, 83 – 89 is respectfully requested.

Claims 59, 60, 62, 63, and 76 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yoseloff and Weingardt, and further in view of U.S. Publication No. 2004/0077422 (“Bryant”). Applicant respectfully traverses this rejection and submits the following with respect to Yoseloff, Weingardt, and Bryant.

Applicant respectfully submits that dependent claims 59, 60, 62, and 63, are allowable as depending from allowable independent claim 9, and that dependent claim 76 is allowable as depending from allowable claim 70. As discussed above, Applicant respectfully submits that the asserted combination of Yoseloff and Weingardt is improper because any such combination would render Yoseloff: 1) nonfunctional for its intended purpose; and 2) change the principle of operation of Yoseloff. Bryant does not cure the deficiencies of Yoseloff and Weingardt. Because the basic requirements of a *prima facie* case of obviousness have not been met with respect to the traversed combination of Yoseloff and Weingardt for the reasons indicated above, the basic requirements of a *prima facie* case of obviousness have also not been met for Yoseloff and Weingardt to be further combined with Bryant. Accordingly, this asserted combination is insufficient to render the claims *prima facie* obvious as per MPEP 2143.01VI, and withdrawal of this rejection is respectfully requested.

Claims 64 and 65 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yoseloff and Weingardt, and further in view of U.S. Publication No. 2002/0042297 (“Torango”).

Applicant respectfully submits that dependent claims 64, and 65 are allowable as depending from allowable independent claim 9. As discussed above, Applicant respectfully submits that the asserted combination of Yoseloff and Weingardt is improper because any such combination would render Yoseloff: 1) nonfunctional for its intended purpose; and 2) change the principle of operation of Yoseloff. Torango does not cure the deficiencies of Yoseloff and Weingardt. Because the basic requirements of a prima facie case of obviousness have not been met with respect to the traversed combination of Yoseloff and Weingardt for the reasons indicated above, the basic requirements of a prima facie case of obviousness have also not been met for Yoseloff and Weingardt to be further combined with Torango. Accordingly, this asserted combination is insufficient to render the claims prima facie obvious as per MPEP 2143.01VI, and withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, reconsideration is respectfully requested. This application should now be in condition for allowance; a notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an accompanying payment, please charge any deficiency to Deposit Account No. 50/2762, Ref. R0586-701010.

Respectfully submitted,
Mark E. Herrmann, et al., Applicants

By: /James C. De Vellis/
James C. De Vellis, Reg. No. 52,814
Edward J. Russavage, Reg. No. 43,069
LOWRIE, LANDO & ANASTASI, LLP
One Main Street
Cambridge, Massachusetts 02142
Telephone: 617-395-7000
Facsimile: 617-395-7070